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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,502	03/08/2001	Ernesto Solis	10001314-1	7453

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

KASSA, YOSEF

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,502

Applicant(s)

SOLIS, ERNESTO

Examiner

YOSEF KASSA

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 28, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, (page 2-5) filed on June 28, 2004, with respect to claims 1-13 under Kato et al (U.S. Patent 6,631,495), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made on claims 1-20 Kato et al (U.S. Patent 6,631,495), and further in view of Withgott et al (U.S. Patent 5,748,805).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-3, 6, 7 and 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al (U.S. Patent 6,631,495), and further in view of Withgott et al (U.S. Patent 5,748,805).

With regard to claim 1, Kato discloses machine readable code, directed to additional information, added to printed material (see col. 2, lines 60-70); a scanner for reading machine readable code connected to an electronic appliance (see Fig. 1, items 6-1 and 6-2) for retrieving and displaying additional information (see Fig. 1, items 2-1, 2-2 and 3 which reads on electronic appliance connection, PC which comprises display

device); and the electronic appliance connected to a local or remote information source (see Fig. 1, device, i.e., electronic appliance, connected to a network system).

Kato does not explicitly call for machine readable code, directed to additional information, added to printed material, and the additional information related to machine readable code. However, in the same field of endeavor Withgott et al (see col. 3, lines 30-43 and col. 3, lines 58-65) teaches this feature. At the time of the invention was made, it would have been obvious to incorporate the teaching of Withgott et al image identifying process into Kato et al system. The motivation for doing so is to provide document retrieving by using supplemental data association with the document.

With regard to claim 2, Kato discloses a printer connected to electronic appliance (see Fig. 1, items 4 and 5-2).

With regard to claim 3, Kato discloses machine readable code is in the form of optical characters (see col. 6, lines 36-45).

With regard to claim 5, Kato discloses scanner is a pencil scanner (see col. 4, lines 48-51).

With regard to claim 6, Kato discloses electronic appliance is a multimedia PC (see Fig. 1, items 2-1 and 2-2).

With regard to claim 7, Kato discloses printed material is advertising flyers (see col. 3, lines 5-10).

Claims 11 and 14 are similarly analyzed as claim 1.

Claim 15 is similarly analyzed as claim 2.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8-10, 12, 13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al (U.S. Patent 6,631,495), Withgott et al (U.S. Patent 5,748,805), and further in view of Antognini et al (U.S. Patent 6,176,427).

With regard to claim 4, while Kato discloses remote connection process, he does not explicitly call for remote information source is an Internet URL. However, in the same field of endeavor Antognini et al (see col. 50, lines 15-18) teaches this feature. At the time of the invention was made, it would have been obvious to incorporate the teaching of Antognini et al writing and reading digital data process into Kato et al document image processing system. The motivation for doing so is to read digital data on paper and printing the digital data onto a substrate along with other information.

With regard to claim 8, Kato discloses printed material is a book and further comprising a copyright clearing application connected to electronic appliance (see col. 6, lines 36-45).

With regard to claim 9, Kato is silent about printed material is in Braille and machine readable code is directed to an audio file. However, in the same field of endeavor Antognini et al (see col. 23, lines 30-37) teaches this feature. At the time of the invention was made, it would have been obvious to incorporate the teaching of

Antognini et al writing and reading digital data process into Kato et al document image processing system. The motivation for doing so is to read digital data on paper and printing the digital data onto a substrate along with other information.

Claims 10 and 16 are similarly analyzed as claim 4.

Claims 12, 17 and 20 are similarly analyzed as claim 8.

Claims 13 and 18 are similarly analyzed as claim 9.

With regard to claim 19, Kato discloses the step of adding machine readable code further comprises the step of adding machine readable code to one of a group including educational books, history books, interactive novels, and music books (see col. 5, lines 29-32).

Other Prior Art Cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. (5,852,684) to Lopresti et al discloses multimedia rendering marker and method.

US Patent No. (6,256,399) to Poor discloses method of distribution of digitized materials and control of...

US Patent No. (6,590,837 to Kaplan discloses apparatus and method for annotating an object...

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSEF KASSA whose telephone number is (703) 306-5918. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BHAVESH MEHTA can be reached on (703) 308-5246. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communication and (703) 872-9306 for after Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (703) 306-5631. The group receptionist number for TC 2600 is (703) 305-4700.

PATENT EXAMINER

Yosef Kassa

10/02/04.

A handwritten signature in black ink, appearing to read 'Yosef Kassa', is written over the printed name and date.